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EXAMINER

AL HASHEMI, SANA A

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/313,278
Filing Date: May 18, 1999
Appellant(s): GOLDENBERG, DAVID M.

Barbara A. McDowell
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/3/2009 appealing from the Office action mailed 11/9/2008.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,039,688	Douglas et al.	3-2000
5,287,448	Nicol et al.	2-1994

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas et al. (U.S. Patent 6,039,688) in view of Nicol et al. (U.S. Patent 5,287,448).

Claim 39: FIG. 1 illustrates a patient and a physician connected to a system interface (18). Any communication made by the physician or patient to the system interface is considered an inquiry from a user. The physician and patient can access different services, with each service being considered a "level of service".

(I) First level of service: Col. 14, lines 38-52 of Douglas et al. describe a first level of service. Col 14, line 40 describe a user generating information about the rewards points system and their own reward points, which occurs by clicking the icon (92) in Fig. 9. The searching of the database in this case is the searching of the record in the computer system containing user's number of accumulated points and identifying the accumulated points, as well as details of the

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rewards system. The results of the search are delivered to the user by allowing the user to view the information (col. 14, line 40).

Douglas differs in that it does not determine a level of user sophistication, or tailor the resulting information based on that sophistication. However, col. 8, lines 35-46 of Nicol et al. describe a help menu feature added to a user interface, in which a user enters their relative level of sophistication, such as "novice", "moderate", or "experienced". The search results then presented to user in response to an information request is then specifically tailored to the input sophistication. A more experienced user will receive less information and a less experienced user will receive more information.

Accordingly, it would have been obvious to one of ordinary skill in the art to modify Douglas et al. to incorporate a help menu at any one or all of its user interfaces for input of user sophistication so as to tailor the specific output results to the user's level of sophistication. This provides the advantage of outputting appropriate messages to aid the user (col. 2, lines 46-47 of "Nicol et al). (All remaining quotations herein are from Douglas et al.).

Claim 40: (II) Second level of service: Col. 16, lines 21-55 describe a second level of service, in which searches are made on the database (computer system) in order to locate "more information", such as a list of articles and internet sites. (III) Third level of service: FIG. 48 illustrates a third level of service in which a user (Fred) is provided with a list of healthcare professionals (Susan). The user (Fred) is referred to the health professional (Susan) via the on\/- outline a fourth level of service is which the physiological condition (vital signs, blood pressure, weight) are monitored. Col. 6, lines 7-13 outline the administration of treatment by ordering that the patient take certain medications or participate in support groups.

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Claims 41-43: The method steps defined by Douglas et al. meet each of parts (A), (B) and (C) defined in claim 40.

Claim 44: The levels of service may be accessed in any order. For example, the user can perform a search of articles and Internet sites (Second Level) before having an on-line meeting with health professional (Third Level of Service). After a given period of time, the user can take recommended medications or participate in support groups (Fourth Level of Service), such as the next day after meeting with the health professional.

Claims 45-47: The method steps defined by Douglas et al. meet each of parts (B) and (C) as defined in claim 40.

Claim 48: FIG. 57 of Douglas et al. illustrates a utilization review system. The user preference is the norm established for the percentage of patients which are desired to be using the system (The listed norm is 17.3%). The weighing function is the measurement of each physician's percentage of patients who participate in the program. The physicians are thus ranked by the percentage of the patients under their supervision who participate in the program. The selection of the user is the designation of which physicians are on the list shown in FIG. 57.

Claim 49: The method of Douglas et al. includes step (C) from claim 40.

Claim 50: As described at col. 6, line 7-13, the user can be instructed via the system to take a medication. These are the telemedicine signals sent to the patient. The implanted device is thus whatever drug the user is asked to take and which releases chemicals into the body.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas et al. in view of Official Notice.

Claim 51: Within the system of Douglas et al., the user can be asked remotely to take medication, but is not asked to undergo surgery. However, Examiner takes Official Notice that the concept of having a physician ask a patient to undergo surgery is very well known in the context of physician - patient interaction. It would therefore have been obvious to one of ordinary skill in the art to modify Douglas et al. to include a recommendation to the remote patient that the patient undergo surgery so as to improve the patient's health and prevent or eliminate disease as is well known in the art.

(10) Response to Argument

Appellant arguments filed 10/31/08 have been fully considered but they are not persuasive.

Appellant argues "there is no suggestion that level of service should be based on user inquiry".

Examiner disagrees. The combined art discloses the argued limitations, by incorporating the options disclosed in the Nicol reference of (novice, moderate, or experienced) which are different level of options to be selected by the user in the Douglas system, the limitation has been met.

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Appellant argues the applied of Douglas in view of the official notice failed to disclose the “administering treatment to the use comprise transmitting telemedicine signal over a network to perform remote surgery”.

Examiner disagrees. As stated in the rejection dated 11/1/07, the physician collect the information from a remote patient in this case the physician can be interpreted as administering treatment, since he is the one will be transmitting the medicine over the network. Further more as shown in Fig. 60, step 1002, wherein the physician enter the patient information and in step 1030 wherein the physician periodically update the patient information which include any treatment. Therefore the Examiner believes the argued limitation has been met.

Appellant argues the combination of Douglas in view of Nicol fails to disclose second and third level of service.

Examiner disagrees. Douglas in the combination of Douglas in view of Nicol discloses (II) Second level of service: Col. 16, lines 21-55 describes a second level of service, in which searches are made on the database (computer system) in order to locate "more information", such as a list of articles and internet sites. (III) Third level of service: FIG. 48 illustrates a third level of service in which a user (Fred) is provided with a list of healthcare professionals (Susan). The user (Fred) is referred to the health professional (Susan) via the on_- outline a fourth level of service is which the physiological condition (vital signs, blood pressure, weight) are monitored. Col. 6, lines 7-13 outline the administration of treatment by ordering that the patient take certain medications or participate in support groups.

Appellant argues with respect to claim 51, the official notice that the concept of having a physician asks a patient to undergo surgery is very well known in the context of physician-

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patient interaction. No prima facie case of obviousness based on Douglas in view of official notice.

Examiner disagrees. Since the Patient is acknowledged with the surgery the patient obviously should be informed with the requirement in performing a remote surgery in the same manner the patient has been informed with the behavior modification as suggested by the physician or the case advisor as disclosed in Douglas Col. 7, lines 53-67, and Col. 8, lines 1-5.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

An Appeal conference was held by Pierre Vital SPE in 2156, Tim Vo SPE in 2168 and Primary Examiner Sana AL-Hashemi, conferee agreed to proceed to the Board of Appeal.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Sana AL-Hashemi/
Primary Patent Examiner

Conferees:

/Tim T. Vo/

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